

RESPONSE

This is in response to the Restriction Requirement issued by the Examiner on February 27, 2008. The Examiner has required that Applicants respond to a restriction requirement pursuant to 35 U.S.C. §§ 121 and 372, electing one of the following inventions:

- I. Claims 50-62, drawn to a composition comprising at least one analgesic drug in combination with at least one non-toxic NMDA receptor antagonist.
- II. Claims 63-66, drawn to a composition comprising at least one opioid analgesic and dextromethorphan, where in the composition is substantially free of opioid antagonist.
- III. Claims 67-76, drawn to a composition consisting essentially of at least one analgesic drug and at least one non-toxic NMDA receptor antagonist.

Applicants herewith elect the Claims of Group II, Claims 63-66 drawn to a composition comprising at least one opioid analgesic and dextromethorphan, and the morphine species of opioid for search purposes only, with traverse.

The Examiner stated that the inventions of Groups I, II, and III do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same corresponding “special technical feature.”

The Examiner stated that the “common technical feature in all groups is a combination of at least one analgesic drug and at least one non-toxic NMDA receptor antagonist. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art,” see Office Action dated February 27, 2008, page 3, second full paragraph.

In making her case for restriction, the Examiner points to Caruso, U.S. Patent No. 6,277,398 (hereinafter “Caruso”) because Caruso discloses topical preparations for trans-

dermal application of the analgesic compositions comprising the topical analgesic capsaicin and the NMDA receptor antagonist dextromethorphan. The Examiner goes on to suggest that no technical feature exists among the different groups because the inventions of Groups I, II, and III fail to make a contribution over the prior art with respect to novelty and inventive step.

Applicants dispute the applicability of the foregoing reason that would justify restriction herein. Because the “expression ‘special technical features’ is defined in Rule 13.2 as meaning **those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any),**” not simply “because the element is shown in the prior art,” as suggested by the Examiner, see M.P.E.P. Annex B, page AI-58 (b), boldface and underline added.

Applicants respectfully disagree with the Examiner’s analysis of the present invention’s lack of unity. Unity of Invention Rule 13.1 provides that an international application should relate to only one invention. However, more than one invention is permitted if “all invention are so linked as to form a single general inventive concept,” see M.P.E.P. Annex B, page AI-58 (a). Unity of invention exists if there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. *Id.* at (b) It is Applicant’s belief that the claims of the present application are linked so as to form “a single general inventive concept,” i.e., an analgesic composition comprising an analgesic drug in an extended release form and an NMDA receptor antagonist in an immediate release form, see instant application, generally, and Claims 50 -76.

For the foregoing reasons, it is believed that all of the instantly pending claims should be examined together with an action being given on the merits with respect to Claims 50 to 76.

Applicants reserve the right to prosecute the subject matter of non-elected claims in other patent applications without prejudice.

An early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter J. Fallon", written in a cursive style.

Peter J. Fallon
Reg. No. 58,331
Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553
(516) 228-8484
(516) 228-8516 (FAX)